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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,668	10/17/2005	Herwig Buchholz	MERCK-2686-1	1550
23599	7590	02/13/2008	EXAMINER	
MILLENN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDRON BLVD. SUITE 1400 ARLINGTON, VA 22201			BLAKELY III, NELSON CLARENCE	
ART UNIT		PAPER NUMBER		
4131		PAPER		
MAIL DATE		DELIVERY MODE		
02/13/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/553,668	<b>Applicant(s)</b> BUCHHOLZ ET AL.
	<b>Examiner</b> NELSON C. BLAKELY III	<b>Art Unit</b> 4131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-34 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) 1-34 are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 

Paper No(s)/Mail Date \_\_\_\_
- 4) Interview Summary (PTO-413)
 

Paper No(s)/Mail Date \_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_

**DETAILED ACTION**

***Application Status***

Claims 1-34 of the instant application are pending.

***Election/Restrictions***

A phone call was not made to the applicant due to the complex nature of the restriction.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

I. Group I, claim(s) 1-16, 33, and 34, drawn to a composition, antimicrobial pigment, obtainable by agitating a suspension comprising one or more inorganic pigments and silver oxide as antimicrobial compound.

II. Group II, claim(s) 17-24, drawn to a method for the preparation of antimicrobial pigments comprising the agitation of a suspension comprising one or more inorganic pigments and silver oxide as antimicrobial compound.

III. Group III, claim(s) 25-32, drawn to the use of antimicrobial pigments according to claim 1 for the inhibition of the growth and/or progeny of microorganisms.

The inventions listed as Groups I, II, and III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features.

An international application should relate to only one invention, or if there is more than one invention, the inclusion of those inventions in one international application is only permitted if all inventions are so linked as to form a single general inventive concept (PCT Rule 13.1). With respect to a group of inventions claimed in an international application, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features.

The expression "special technical features" is defined in PCT Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any). Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature", should be considered with respect to novelty and inventive step.

The common technical feature in all groups is a composition comprising antimicrobial pigments, obtainable by agitating a suspension comprising one or more inorganic pigments and silver oxide as antimicrobial compound. This composition cannot be a special technical feature under PCT Rule 13.2 because the composition is shown in the prior art.

Goetz *et al* (Reversible Photolysis of Ag Sorbed on Colloidal Metal Oxides, *Reviews of Modern Physics*, Volume 20, Number 1, pages 131-133, 1948; from applicant's Information Disclosure Statement) teaches the preparation, by agitation, of photosensitive material involving utilizing an inorganic particle, or pigment, attached to a substrate consisting of a metal oxide. Additionally, beginning in line 3 on page 13 of the disclosure, applicant recites that the preferred process of producing the pigments includes the agitation of a suspension comprising one or more inorganic pigments and silver oxide while also citing the previous source. Thus, there is no "special technical feature", which renders this restriction requirement proper.

The previous reference was taken from applicant's Information Disclosure Statement. Form 1449 will be considered in its entirety upon first Office Action.

***Election of Species***

Regardless of the invention elected, applicant is also required to elect from disclosed species:

- (a) a species of pigments selected from those listed in claim 3 of the instant application;
- (b) a species of substrates selected from those listed in claim 5 of the instant application;
- (c) the composition of the layer(s) in which the substrate is coated selected from the (those) list(ed) in claims 6-9 of the instant application;

- (d) a species of spherical particles or capsules and the composition of the layer(s) as illustrated in claims 10 and 11 of the instant application;
- (e) the species of which the protective layer is comprised selected from those listed in claims 13 and 23 of the instant application;
- (f) a species, in which silver oxide is substituted, selected from those listed in claims 15 and 20 of the instant application; and
- (g) the compound(s) selected from the group listed in claim 34 that serve(s) as suitable substrates for microorganisms.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

***Conclusion***

Claims 1-34 are subjected to restriction and/or election requirement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NELSON C BLAKELY III whose telephone number is (571)270-3290. The examiner can normally be reached on Mon - Thurs, 7 am - 5:30 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571) 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. C. B.III/  
Examiner, Art Unit 4131

/Cecilia Tsang/  
Supervisory Patent Examiner, Art Unit 4131

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